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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/561,862	12/20/2005	Hiroyuki Anzai	UNU90.001APC	5508
20995 7590 12/30/2009 KNOBBE MARTENS OLSON & BEAR LLP 2040 MAIN STREET FOURTEENTH FLOOR IRVINE, CA 92614				
EXAMINER				
RIOJA, MELISSA A				
ART UNIT		PAPER NUMBER		
1796				
NOTIFICATION DATE		DELIVERY MODE		
12/30/2009		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

jcartee@kmob.com
eOAPilot@kmob.com

Office Action Summary

Application No.

10/561,862

Applicant(s)

ANZAI ET AL.

Examiner

MELISSA RIOJA

Art Unit

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on September 30, 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/22)
- Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on September 30, 2009 has been entered.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 2002-201251 to Ota et al. in view of US 5,895,793 to Kitamura et al. The citations for JP

2002-201251 have been taken from the English-language abstract and machine translation of the document made available by the Japan Patent Office.

Regarding Claims 1 and 3. Ota et al. teach a composition for preparing a rigid polyurethane foam comprising a polyol, a blowing agent, foam stabilizer, and a catalyst (Abstract: "Solution"; Detailed Description: Paragraphs 9, 11, and 12; Detailed Description: Example 1). The blowing used is a mixture of 1 – 75 percent weight HFC-245fa and 99 – 25 percent weight HFC-365mfc (Abstract: "Solution").

Ota et al. do not expressly teach the composition further comprises a compatibilizer. However, Kitamura et al. teach a blowing agent composition useful in forming polyurethane foams comprising HFC-245fa and a stabilizing compound such as γ -butyrolactone. The stabilizer is incorporated in the composition in an amount of 0.001 to 10 parts by weight per 100 parts HFC-245fa (Column 2, Lines 7 – 59; Example 4). Ota et al. and Kitamura et al. are analogous art as they are from the same field of endeavor, namely compositions for preparing polyurethane foams comprising HFC-245fa as a blowing agent. At the time of invention, it would have been obvious to a person of ordinary skill in the art to use a stabilizer in the amount taught by Kitamura et al. in the composition taught by Ota et al. The motivation would have been that use of the stabilizers taught by Kitamura et al. in conjunction with HFC-245fa prevents HFC-245fa from deactivating the catalyst when forming a polyurethane foam or

causing yellowing in the final foam product (Kitamura et al.: Column 1, Lines 27 - 31 and 53 - 60; Column 1, Line 66 - Column 2, Line 6).

Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 2002-201251 to Ota et al. in view of US 5,895,793 to Kitamura et al., as applied to Claims 1 and 3 above, and further in view of US 6,319,962 to Singh et al. The citations for JP 2002-201251 have been taken from the English-language abstract and machine translation of the document made available by the Japan Patent Office.

Regarding Claims 4 and 5. Ota et al. teach the composition of Claim 3 wherein the polyol may be prepared by reacting alkylene oxide with an initiator (Detailed Description: Paragraph 9). Ota et al. are silent regarding the specific initiators which may be used. However, Singh et al. teach making polyurethane foams with polyether polyols that are prepared by the reaction of alkylene oxide with an initiator such as ethylene diamine or sorbitol (Column 6, Lines 4 – 10). Ota et al. and Singh et al. are analogous art as they are from the same field of endeavor, namely rigid polyurethane foams. At the time of invention, it would have been obvious to a person of ordinary skill in the art to prepare the polyols taught by Ota et al. using the initiators taught by Singh et al. The motivation would have been that the initiators taught by Singh et al. are suitable for the preparation of polyethers useful in preparing rigid polyurethane foams (Singh et al.: Column 4, Line 65 – Column 5, Line 2).

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over JP 2002-201251 to Ota et al. in view of US 5,895,793 to Kitamura et al., as applied to Claims 1 and 3 above, and further in view of US 6,319,962 to Singh et al. and US 6,313,060 to Sugiyama et al. The citations for JP 2002-201251 have been taken from the English-language abstract and machine translation of the document made available by the Japan Patent Office.

Regarding Claim 6. Ota et al. teach the polyol composition of Claim 3 but do not teach it comprises an aromatic polyol obtained by addition of an alkylene oxide to a polyfunctional active hydrogen compound having an aromatic ring. However, Sugiyama et al. also teach a polyether polyol produced by addition of an alkylene oxide to a polyhydroxy compound (Column 8, Lines 12 – 20). Sugiyama et al. specifically cite bisphenol A, a polyfunctional active hydrogen compound with an aromatic ring, as a suitable polyhydroxy compound for reaction with the alkylene oxide (Column 8, Lines 26 – 35). Ota et al. and Sugiyama et al. are analogous art as they are from the same field of endeavor, namely polyurethane foams. At the time of invention, it would have been obvious to a person of ordinary skill in the art to include the aromatic polyol taught by Sugiyama et al. in the polyol composition taught by Ota et al. The motivation would have been that the polyether polyol taught by Sugiyama et al. has been found to

minimize problems, such as a decrease in hardness and deterioration of compression set, associated with polyurethane foams prepared from other, conventional polyols (Sugiyama et al., Column 9, Lines 35 - 42).

Ota et al. do teach the polyol composition may comprise a polyester prepared from the reaction of a polycarboxylic acid and a polyhydric alcohol (Detailed Description: Paragraph 9). Ota et al. are silent regarding specific polycarboxylic acids that may be used. However, Singh et al. also teach preparing polyester polyols from the reaction of a polycarboxylic acid and a polyhydric alcohol. Suitable polyester polyols include aromatic polyester polyols prepared using an aromatic polycarboxylic acid (Column 5, Lines 13 – 37). At the time of invention, it would have been obvious to a person of ordinary skill in the art to use an aromatic polycarboxylic acid when preparing the polyester polyol taught by Ota et al. The motivation would have been that aromatic polyester polyols impart advantages to polyurethane foam such as improved heat resistance in the foam product.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over JP 2002-201251 to Ota et al. in view of US 5,895,793 to Kitamura et al. The citations for JP 2002-201251 have been taken from the English-language abstract and machine translation of the document made available by the Japan Patent Office.

Regarding Claim 2. Ota et al. teach a method for preparing a rigid polyurethane foam comprising reacting an isocyanate with a polyol component in the presence of a blowing agent, a foam stabilizer, and a catalyst (Abstract: "Solution"; Detailed Description: Paragraphs 9 - 12; Detailed Description: Example 1). The blowing used is a mixture of 1 – 75 percent weight HFC-245fa and 99 – 25 percent weight HFC-365mfc (Abstract: "Solution").

Ota et al. do not expressly teach the composition further comprises a compatibilizer. However, Kitamura et al. teach a blowing agent composition useful in forming polyurethane foams comprising HFC-245fa and a stabilizing compound such as N,N-dimethylacetamide or γ -butyrolactone. The stabilizer is incorporated in the composition in an amount of 0.001 to 10 parts by weight per 100 parts HFC-245fa (Column 2, Lines 7 – 53; Example 4). At the time of invention, it would have been obvious to a person of ordinary skill in the art to use a stabilizer in the amount taught by Kitamura et al. in the composition taught by Ota et al. The motivation would have been that use of the stabilizers taught by Kitamura et al. in conjunction with HFC-245fa prevents HFC-245fa from deactivating the catalyst when forming a polyurethane foam or causing yellowing in the final foam product (Kitamura et al.: Column 1, Lines 27 - 31 and 53 - 60; Column 1, Line 66 - Column 2, Line 6).

Claims 7 – 9 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 2002-201251 to Ota et al. in view of US 5,895,793 to Kitamura et al. The citations for JP 2002-201251 have been taken from the English-language abstract and machine translation of the document made available by the Japan Patent Office.

Regarding Claims 7 and 9. Ota et al. teach a composition for preparing a rigid polyurethane foam comprising a polyol, a blowing agent, a foam stabilizer, and a catalyst (Abstract: “Solution”; Detailed Description: Paragraphs 9, 11, and 12; Detailed Description: Example 1). The blowing used is a mixture of 1 – 75 percent weight HFC-245fa and 99 – 25 percent weight HFC-365mfc (Abstract: “Solution”).

Ota et al. do not expressly teach the composition further comprises a compatibilizer. However, Kitamura et al. teach a blowing agent composition useful in forming polyurethane foams comprising HFC-245fa and a stabilizing compound such as γ -butyrolactone. The stabilizer is incorporated in the composition in an amount of 0.001 to 10 parts by weight per 100 parts HFC-245fa (Column 2, Lines 7 – 53; Example 4). At the time of invention, it would have been obvious to a person of ordinary skill in the art to use a stabilizer in the amount taught by Kitamura et al. in the composition taught by Ota et al. The motivation would have been that use of the stabilizers taught by Kitamura et al. in conjunction with HFC-245fa prevents HFC-245fa from deactivating the catalyst when forming a polyurethane foam or causing yellowing in

the final foam product (Kitamura et al.: Column 1, Lines 27 - 31 and 53 - 60; Column 1, Line 66 - Column 2, Line 6).

Regarding Claim 8. Ota et al. teach the composition of Claim 7 is reacted with a polyisocyanate compound (Abstract: "Solution").

Regarding Claim 13. Ota et al. teach a method of making a rigid polyurethane foam in which the composition of Claim 7 is mixed with polyisocyanate and then foamed to produce a rigid foam product (Detailed Description: Paragraph 12 and Example 1).

Claims 10 - 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 2002-201251 to Ota et al. in view of US 5,895,793 to Kitamura et al., as applied to Claims 7 and 9 above, and further in view of US 6,319,962 to Singh et al. The citations for JP 2002-201251 have been taken from the English-language abstract and machine translation of the document made available by the Japan Patent Office.

Regarding Claims 10 and 12. Ota et al. teach the composition of Claim 9 wherein the polyol may be prepared by reacting alkylene oxide with an initiator (Detailed Description: Paragraph 9). Ota et al. are silent regarding the specific initiators which may be used. However, Singh et al. teach making polyurethane foams with polyether polyols prepared by the reaction of alkylene oxide with an initiator such as

ethylene diamine or sorbitol (Column 6, Lines 4 – 10). At the time of invention, it would have been obvious to a person of ordinary skill in the art to prepare the polyols taught by Ota et al. using the initiators taught by Singh et al. The motivation would have been that the initiators taught by Singh et al. are suitable for the preparation of polyethers useful in preparing rigid polyurethane foams (Singh et al.: Column 4, Line 65 – Column 5, Line 2).

Regarding Claim 12. Ota et al. teach the polyol composition of Claim 9 may comprise a polyester prepared from the reaction of a polycarboxylic acid and a polyhydric alcohol (Detailed Description: Paragraph 9). Ota et al. are silent regarding specific polycarboxylic acids that may be used. However, Singh et al. also teach preparing polyester polyols from the reaction of a polycarboxylic acid and a polyhydric alcohol. Suitable polyester polyols include aromatic polyester polyols prepared using an aromatic polycarboxylic acid (Column 5, Lines 13 – 37). At the time of invention, it would have been obvious to a person of ordinary skill in the art to use an aromatic polycarboxylic acid when preparing the polyester polyol taught by Ota et al. The motivation would have been that aromatic polyester polyols imparts advantages to polyurethane foam such as improved heat resistance in the foam product.

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over JP 2002-201251 to Ota et al. in view of US 5,895,793 to Kitamura et al., as applied to Claims 7 and 13 above, and further in view of US 6,319,962 to US 5,164,419 to Bartlett et al. The citations for JP 2002-201251 have been taken from the English-language abstract and machine translation of the document made available by the Japan Patent Office.

Regarding Claim 14. Ota et al. teach the method of Claim 13 but are silent regarding the NCO:OH ratio. However, Bartlett et al. also teach a method of making a rigid polyurethane foam in which the isocyanate index/NCO:OH ratio is preferably in the range of about 1.0 to about 4.0 (Column 5, Lines 9 – 14). Ota et al. and Bartlett et al. are analogous art as they are from the same field of endeavor, namely rigid polyurethane foams. At the time of invention, it would have been obvious to a person of ordinary skill in the art to react the polyol and isocyanate components taught by Ota et al. at the isocyanate index taught by Bartlett et al. The motivation would have been that the isocyanate index taught by Bartlett et al. provides advantages such as stiffness and minimal shrinkage in the final foam product.

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over JP 2002-201251 to Ota et al. in view of US 5,895,793 to Kitamura et al., as applied to Claims 7 and 13 above, and further in view of US 5,786,400 to Brock et al. The citations for JP 2002-

201251 have been taken from the English-language abstract and machine translation of the document made available by the Japan Patent Office.

Regarding Claim 15. Ota et al. teach the method of Claim 13 but do not expressly teach the temperature at which the isocyanate and polyol components are reacted. However, Brock et al. teach a method of making a polyurethane foam wherein the isocyanate and polyol mixture are blended at a temperature of 20°C (Column 6, Lines 48 – 53). Ota et al. and Brock et al. are analogous art as they are from the same field of endeavor, namely rigid polyurethane foams. At the time of invention, it would have been obvious to a person of ordinary skill in the art to react the isocyanate and polyol components in the invention of Ota et al. at the temperature taught by Brock et al. The motivation would have been that the reaction temperature taught by Brock et al. provides advantages such as avoiding the decomposition of the reactants and providing a reaction rate that is practicable in industrial applications.

Response to Arguments

Applicant's arguments filed September 30, 2009 have been fully considered but they are not persuasive because:

A) Applicant argues that Ota et al. do not teach applicant's claimed ratio of HFC-245fa to HFC-365mfc with sufficient specificity. Ota et al. teaches an HFC-245fa content

of 1 – 75 weight percent, whereas applicant's claimed ratio correspond to an HFC-245fa content of greater than 60 weight percent. The range taught by Ota et al. consequently overlaps with applicant's claimed range. In the case where the claimed ranges "overlap or lie inside ranges disclosed by the prior art," a *prima facie* case of obviousness exists. *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976); *In re Woodruff*, 919 F.2d 1575, 16 YSPQ2d 1934 (Fed Cir. 1990) (MPEP 2144.05)

An affidavit of declaration under 37 CFR 1.132 must compare the claimed subject matter with the closest prior art to be effective to rebut a *prima facie* case of obviousness. *In re Burckel*, 592 F.2d 1175, 201 USPQ 67 (CCPA 1979) (MPEP 716.02(c)) Applicant has consequently provided a declaration to support the argument that unexpected results are achieved when the claimed content of HFC-245fa is used.

However, the declaration submitted is unpersuasive. It has been held that, whether the unexpected results are the result of unexpectedly improved results or a property not taught by the prior art, the "objective evidence of nonobviousness must be commensurate in scope with the claims which the evidence is offered to support." In other words, the showing of unexpected results must be reviewed to see if the results occur over the entire claimed range (i.e., scope). *In re Clemens*, 622 F.2d 1029, 1036, 206 USPQ 289, 296 (CCPA 1980), MPEP 716.02(d). In the instant case, the evidence provided is not commensurate in scope with instant claims because the compatibilizer,

e.g. γ -butyrolactone, required by the instant claims is not present in the foam compositions.

Additionally, to establish unexpected results over a claimed range, applicants should compare a sufficient number of tests both inside and outside the claimed range to show the criticality of the claimed range. *In re Hill*, 284 F.2d 955, 128 USPQ 197 (CCPA 1960) (MPEP 716.02(d)) Even were the experiments to include the required compatibilizer, the contents of HFC-245fa and HFC-365mfc selected would be insufficient to prove an unexpected results occur at contents of HFC-245fa specifically at 60 percent and above. The compositions in the declaration have contents of HFC-245fa at 50 and 100 percent. A content of HFC-245fa at 50 percent would not be sufficiently close to 60 percent to prove an unexpected dimensional stability occurs at 60 weight percent and above. A content of HFC-245fa of 100 percent is not commensurate in scope with the instant claims, which require the presence of HFC-365mfc.

B) Applicant has also indicated that secondary reference Kitamura et al. does not teach the only compatibilizer now set forth in Claim 1. However, the Office respectfully disagrees, as Kitamura et al. teach the addition of γ -butyrolactone to polyurethane foams comprising HFC-245fa (see Column 2, Lines 7 – 59 and Example 4).

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MELISSA RIOJA whose telephone number is (571)270-3305. The examiner can normally be reached on Monday - Friday 7:00AM - 3:30PM E.S.T..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Eashoo can be reached on (571)272-1197. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Mark Eashoo/
Supervisory Patent Examiner, Art Unit 1796

/MAR/
December 19, 2009